

Docket No.: 29929/38327
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Daniel H. Hilbrich

Application No.: 10/047,852 Confirmation No.: 5104

Filed: January 15, 2002 Art Unit: 3742

For: Filtering Device for an Espresso-Type Coffee Examiner: Reginald Alexander
Maker

APPELLANT'S REPLY BRIEF ON APPEAL

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This paper is in response to the Examiner's Answer dated September 16, 2008. As required under § 41.41(a)(1), this brief is filed within two months of the Examiner's Answer.

This brief contains items under the following headings as required by 37 C.F.R. § 41.37 and M.P.E.P. § 1208:

- I. Status of Claims
- IV. Grounds of Rejection to be Reviewed on Appeal
- VII. Argument

I. STATUS OF CLAIMS

Claims 1-8, 10-12, 14-21, and 23-28 are pending in this reissue application. Claims 9, 13, and 22 have been canceled.

Claims 1-8, 10-12, 14-21, and 23-28 stand rejected based on the most recent official action dated February 13, 2008, and a subsequent advisory action dated April 30, 2008.

The rejections of claims 1-8, 10-12, 14-21, and 23-28 are being appealed.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

As a result of the advisory action mailed April 30, 2008, (a) claims 1, 4, 5, 7, 8, 10-12, 14-18, 21, 23-25, 27, and 28 stand rejected under 35 U.S.C. § 103(a) as obvious over Smith et al. U.S. Patent No. 5,403,605 ("Smith") in view of Giuliano, U.S. Patent No. 5,490,447 ("Giuliano"); and (b) claims 2, 3, 6, 19, 20, and 26 stand rejected under 35 U.S.C. § 103(a) as obvious over Smith in view of Giuliano and further in view of Krebs, U.S. Patent No. 4,052,318 ("Krebs").

The issues on appeal are (a) whether the combination of Smith and Giuliano renders claims 1, 4, 5, 7, 8, 10-12, 14-18, 21, 23-25, 27, and 28 obvious, and (b) whether the combination of Smith, Giuliano, and Krebs renders claims 2, 3, 6, 19, 20, and 26 obvious.

III. ARGUMENT

A. Rejection of Claims 1, 4, 5, 7, 8, 10-12, 14-18, 21, 23-25, 27, and 28 as Obvious

Claims 1, 4, 5, 7, 8, 10-12, 14-18, 21, 23-25, 27, and 28 stand rejected as obvious over Smith in view of Giuliano. The appellant submits that these claims are not obvious in view of Smith and Giuliano at least because the combination of Smith and Giuliano fails to disclose each and every limitation of the claimed invention and because Smith teaches away from the claimed invention.

Independent claims 1, 4, and 21 are directed to a device for filtering espresso-type coffee grounds having a size of 0.3 mm or less. Independent claims 7 and 17 are directed to a method of making lower lipids-containing brewed espresso-type coffee. Each of the independent claims recites the combined use of a permanent filter and a paper filter. Additionally, the claims each recite that the permanent filter has openings sized to filter out the fine espresso coffee grounds having a size of 0.3 mm or less.

1. The Combination of Smith and Giuliano Fails to Disclose or Suggest the Combined Use of a Paper Filter and a Permanent Filter

In support of the rejection under 35 U.S.C. § 103(a), the Examiner's Answer arbitrarily concludes that because "the foraminous support 44 of Smith is cited in the reference along with the paper filter 42 as being part of the filter assembly 40 . . . it is made clear that the two elements together are meant to operate as a filtering unit." It is respectfully submitted that the examiner misinterprets the disclosure of Smith.

Smith states that "the filter assembly 40, *in addition to filter element 42*, includes foraminous support sheet 44, . . . which offers strength to support filter element 42 . . ." *Smith*, col. 4, lines 38-41. Thus, while the foraminous support 44 and filter element 42 are apart of the filter assembly, this disclosure does *not* support the examiner's conclusion that the foraminous support sheet 44 is intended to function to filter out coffee grounds having a size of 0.3 mm or less. In fact, the disclosure of Smith requires the opposite conclusion. Smith explicitly discloses that the foraminous support 44 functions to support the filter element 42 and includes openings having a diameter from 1 to 2.5 millimeters in diameter, which are spaced

from 1.25 to 5 millimeters apart from center to center. See Herrick et al., U.S. Patent No. 5,190,653 (“Herrick”), col. 3, lines 22-32 (Smith expressly incorporates the disclosure of Herrick by reference. Smith, col. 2, lines 66-68 to col. 3, lines 1-2). “[T]his is far different from the filter element.” Herrick, col. 3, lines 32-33. Accordingly, the foraminous support 44 does not function and is not intended to function as a filter, much less as a filter sized to filter coffee grounds having a size of 0.3 mm or less, as in the claimed invention.

As recognized by the examiner, Giuliano discloses the use of only a permanent filter 96 in an espresso-type coffee maker. Thus, Giuliano cannot cure the defect of Smith. Accordingly, the combination of Smith and Giuliano fails to disclose each and every element of the claimed invention. Therefore, a *prima facie* case of obviousness cannot be based on the combination of Smith and Giuliano.

2. Regardless of Whether the Foraminous Support can be Properly Characterized as a Filter, There is No Motivation to Combine Smith and Giuliano

In further support of the rejection under 35 U.S.C. § 103(a), the examiner arbitrarily concludes that because both Smith and Giuliano are directed to the production of an espresso-type coffee beverage there is a motivation to combine Smith and Giuliano to modify the foraminous support of Smith to include the smaller sized apertures of the Giuliano permanent filter.

It is respectfully submitted that the examiner completely ignores the express teaching in Smith that the foraminous support 44 includes the maximum open area consistent with strength and has 1 to 2.5 millimeter diameter openings that are spaced apart 1.25 to 5 millimeters from center to center. Smith, col. 2, lines 14-18, and Herrick, col. 3, lines 22-23, and 29-30. One of ordinary skill in the art would not be motivated to modify the foraminous support to include openings sized to filter coffee grounds having a size of 0.3 mm or less, as recited in the claimed invention, because such modification would require one to destroy or disregard the express teaching in Smith that the foraminous support 44 includes openings having a diameter of 1 to 2.5 millimeters.

One of ordinary skill in the art would also not be motivated to reduce the size of the foraminous support 44 opening because it would require one to destroy or disregard the express teaching that the foraminous support 44 includes the maximum open area consistent with space. Decreasing the size of the openings even while increasing the number of openings is contrary to the express teaching that the foraminous support 44 have the maximum open area consistent with strength, because the openings must remain spaced apart as expressly taught by Smith (1.25 to 5 millimeters from center to center). Accordingly, because the distance between openings is measured from center to center, the spacing between the edges of the openings, representing the closed spaced between openings, is actually greater in a support 44 having smaller sized openings. Thus, Smith teaches away from reducing the size of the openings to filter coffee grounds having a size of 0.3 mm or less. See *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994) (“A reference may be said to teach away when a person of ordinary skill, upon reading the reference . . . would be led in a direction divergent from the path that was taken by the applicant.”)

“It is improper to combine references where the references teach away from their combination” MPEP § 2145(X)(D)(2) (citing *In re Grasselli*, 713 F.2d 731, 743 (Fed. Cir. 1983)). Therefore it would be improper to combine Smith with Giuliano or any other reference teaching a filter having openings having a diameter of less than 1 mm to 2.5 mm and that are spaced apart less than 1.25 to 5 millimeters from center to center. Thus, a *prima facie* case of obviousness cannot be based in whole or in part on *Smith*. *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1354 (Fed. Cir. 2001) (noting that as a general rule “references that teach away cannot serve to create a *prima facie* case of obviousness”) (citing *In re Gurley*, 27 F.3d at 553); and *Tec Air Inc. v. Denso Mfg. Mich. Inc.*, 192 F.3d 1353, 1360 (Fed. Cir. 1999) (“There is no suggestion to combine, however, if a reference teaches away from its combination with another source.”).

Accordingly, independent claims 1, 4, 7, 17, and 21, and claims 5, 8, 10-12, 14-16, 18, 23-25, 27, and 28 depending therefrom, are allowable over the cited references.

B. Rejection of Claims 2, 3, 6, 19, 20, and 26 as Obvious

The rejection of claims 2, 3, 6, 19, 20, and 26 is premised on the assertion that the combination of Smith and Giuliano discloses each and every limitation of the independent claims from which they depend. As shown above, the inventions of independent claims 1, 4, 7, and 21 are allowable over the combination of Smith and Giuliano. Therefore, dependent claims 2, 3, 6, 19, 20, and 26 are also allowable.

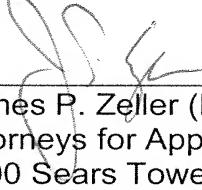
C. Conclusion

In view of the foregoing, the appellant submits that (a) claims 1, 4, 5, 7, 8, 10-12, 14-18, 21, 23-25, 27, and 28 are not obvious over the combination of Smith and Giuliano, and (b) claims 2, 3, 6, 19, 20, and 26 are not obvious the combination of Smith, Giuliano, and Krebs. Accordingly, the appellant respectfully requests reversal of the above rejections.

Respectfully submitted,

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